



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,138	11/21/2001	Paul J. Gilligan	PH-7094-A	2310

24348 7590 02/07/2002

BRISTOL-MYERS SQUIBB PHARMA COMPANY
PATENT DEPARTMENT
P.O. BOX 4000
PRINCETON, NJ 08543-4000

EXAMINER

FORD, JOHN M

ART UNIT	PAPER NUMBER
----------	--------------

1624

3

DATE MAILED: 02/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/99038

Applicant(s)

Gilligan et al

Examiner

V.M. Ford

Group Art Unit

1624

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1--13 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1--13 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 1624

The claims in the application are claims 1--13.

This application has been found to contain more than one invention. Therefore, restriction to one of the following distinct invention is required:

(I) The instances in claims 1--8 where A is N and B is CR4, the as-triazines in class 544-184, with which claim 7 joins.

(II) The instances in claims 1--8 where A is CR5 and B is N, the symmetrical triazines in 544-180, depending on the R3 and R5.

(III) The instances where A and B are both N, and the (top) N is CR⁴, claim 10.

These distinct invention have acquired separate status in the art, will support separate patents, and will require different fields of search for the respective inventions. Accordingly, for examination purposes, as indicated, is considered proper; 35 U.S.C. 121; 37 CFR 1.141 and 37 CFR 1.142.

Claim 1 constitutes *re: lack of unity* of inventions, as it groups together species inventions that are distinct and separately classified, and will support separate patents. Ex parte Markush, 1925 C.D. 126, provided for this claim structure where there was an emergency engendered need, as the substances were "so closely related that they would not support series of patents". This is not the case here. Therefore, the instant generic claims constitute an improper joinder of inventions; Ex parte Reid, 105 U.S.P.Q. 251; IN re Winnek, 73 U.S.P.Q. 225; In re Ruzicka, 66 U.S.P.Q. 226.

Claim 11 and 12 are non-statutory.

Art Unit: 1624

Claim 13 will be examined with either Group.

Claims 11 and 12 violate 35 U.S.C., 101 and 35 U.S.C. 112, since it is drafted in terms of use. See *Clinical Products vs. Brenner*, 2255 F. Supp. 151; 149 USPQ 475 (D.C. District Columbia 1966).

For use in therapy, as to antagonize a CDF-1 receptor is not specific enough to satisfy the Utilities Guidelines.

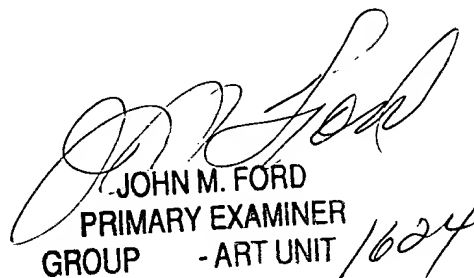
Applicant should pick one, demonstrable, understandable, specific utility from claim 12 ~~that~~ relates the real World of Commerce, that applicants can show data on, in regard to

This application has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation is, therefore, requested in promptly correcting any errors of which they may become aware in the specification.

Applicants' response must include a provisional election, even if the requirement be traversed, see 37 CFR 1.143. And 37 CFR 1.144.

J. Ford:jmr

Jan. 31, 2002


JOHN M. FORD
PRIMARY EXAMINER
GROUP - ART UNIT 1624